



ilu
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,830	05/01/2001	Paul Andrew Moskowitz	YOR920000311 (1963-5013)	4970

7590 01/30/2004

STEPHEN C. KAUFMAN
INTERNATIONAL BUSINESS MACHINES CORPORATION
P.O. BOX 218
ROUTE 134/1101 KITCHAWAN ROAD
YORKTOWN HEIGHTS, NY 10598

EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,830

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-12 recite the limitation "the additional information" in lines 3 and 8 respectively. There is insufficient antecedent basis for this limitation in the claims.

3. Claims 1 and 6 recite the limitation "the entry modality" in lines 3 and 8 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2645

6. Claims 1-2, 4-7,9-10 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Masek** (US 5,272,749) in view of **Enzmann et al.** (US 6,320,946).

As to Claim 1, with respect to Figure 1, **Masek** teaches a method for connecting a user to a telephone number, comprising the steps of:

- a) receiving a phone address entered by a caller (Col. 8, lines 64-67);
- b) determining special feature access (the entry modality) used by said caller to enter the received phone address (Col. 9, lines 3-6, 27-29);
- c) decoding said received phone address according to the determined entry modality (Col. 9, lines 42-58);
- d) consulting a SFAS translation library (reference table) using the decoded phone address, said reference table being updated by a CO translation library (centralized master reference table) (Col. 8, lines 34-30 and Col. 9, lines 45-54); and
- e) connecting the caller to the telephone number that results from said step of consulting the reference table (Col. 10, lines 33-40);

Masek does not teach the following limitation:

“periodically updated”

Enzmann teaches a SMS computer (centralized master reference table) periodically updating an information server (reference table) (Col. 12, lines 28-34 and Col. 14, lines 31-38,50-54). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add periodic update capability to **Masek’s** invention for

Art Unit: 2645

updating databases with recent information as taught by **Enzmann's** invention in order to provide choices for updating databases.

As to Claims 2,7, **Masek** teaches the method of claim 1, wherein the decoded phone address is an ambiguous phone address (Col. 8, lines 64-67 and Col. 19, line 62 through Col. 20, line 2).

As to Claims 4-5,9-10, **Masek** teaches the method of claim 1 wherein said reference table is a lookup table (Col. 9, lines 49-54).

As to Claims 6, 19-21, with respect to Figure 1, **Masek** teaches a system for connecting a user to a telephone number, comprising:

a memory, 40, having program code stored therein (Figure 1 and Col. 9, lines 3-20); and

a processor, 14, connected to said memory for carrying out instructions in accordance with stored program code (Figure 1 and Col. 9, lines 3-20);

wherein said program code, when executed by said processor, causes said processor to perform the steps of:

a) receiving a phone address entered by a caller (Col. 8, lines 64-67);

b) determining the entry modality used by said caller to enter the received phone address (Col. 9, lines 3-6, 27-29);

c) decoding said received phone address according to the determined entry modality (Col. 9, lines 42-58);

Art Unit: 2645

d) consulting a reference table using the decoded phone address, said reference table being updated by a centralized master reference table (Col. 8, lines 34-30 and Col. 9, lines 45-54); and

e) connecting the caller to the telephone number that results from said step of consulting the reference table (Col. 10, lines 33-40);

Masek does not teach the following limitation:

“periodically updated”

Enzmann teaches a SMS computer (centralized master reference table) periodically updating an information server (reference table) (Col. 12, lines 28-34 and Col. 14, lines 31-38,50-54). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add periodic update capability to **Masek’s** invention for updating databases with recent information as taught by **Enzmann’s** invention in order to provide choices for updating databases.

7. Claims 3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Masek** in view of **Enzmann** and further in view of **Clitherow** (US 5,479,494).

As to Claims 3,8, **Masek** teaches the method of claim 2 wherein said step of consulting the reference table further includes consulting said table;

Masek does not teach the following limitation:

“using additional information specified by an ambiguity resolving parameter, and wherein said step of connecting the caller is not performed if no telephone number results from said step of consulting”

Art Unit: 2645

Clitherow teaches using external database entries (additional information) by card issuer prefixes (an ambiguity resolution parameter) and not connecting a caller if a telephone number is not found (Figure 4, labels 318320,308). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add ambiguity resolving capability to **Masek's** invention for matching dialed virtual numbers as taught by **Clitherow's** invention in order to provide assistance to callers when placing calls to virtual numbers.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-18,22-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Riskin** (US 4,817,129).

As to Claims 11,13,15, with respect to Figure 14, **Riskin** teaches a method for determining telephone numbers, comprising the steps of:

- a) receiving from a caller an ambiguous phone address (Col. 20, lines 15-20);
- b) collecting the additional information specified by a collision (an ambiguity resolving parameter) (Col. 20, lines 8-12 and Col. 16, lines 37-56); and
- c) determining, using said additional information, whether said phone address resolves to a telephone number (Col. 16, lines 51-56).

Art Unit: 2645

As to Claims 12,14,17,30-31, with respect to Figure 14, **Riskin** teaches a system for determining telephone numbers, comprising:

- a memory having program code stored therein (Figure 14, label 42); and

- a processor connected to said memory for carrying out instructions in accordance with stored program code (Figure 1, label 16);

- wherein said program code, when executed by said processor, causes said processor to perform the steps of:

- a) receiving from a caller an ambiguous phone address (Figure 14, label 40);

- b) collecting the additional information specified by a collision (an ambiguity resolving parameter) (Figure 14, label 48); and

- c) determining, using said additional information, whether said phone address resolves to a telephone number (Figure 14, label 50).

As to Claims 16,18, **Riskin** teaches the method of claim 11, wherein said ambiguous phone address maps to more than one telephone number (Figure 14, label 48).

As to Claims 22,26, **Riskin** teaches the method of claim 11, wherein said additional information is the caller's present location (Col. 5, lines 45-54).

As to Claims 23,27, **Riskin** teaches the method of claim 11, wherein said additional information is the telephone number the call is being placed from (Col. 11, lines 45-54).

Art Unit: 2645

As to Claims 24,28, **Riskin** teaches the method of claim 11, wherein said additional information is the identity of the caller (Col. 11, lines 45-54).

As to Claims 25,29, **Riskin** teaches the method of claim 11, wherein said additional information is the caller's response to one or more queries (Col. 16, lines 50-56).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Borges et al. (US 4,839,919) teach a telephone which processes alpha-numeric inputs and returns telephone numbers.

Reding et al. (US 5,812,657) teach an operator workstation which receives and converts vanity numbers into actual telephone numbers.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

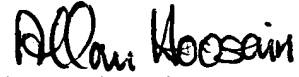
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Application/Control Number: 09/846,830

Page 9

Art Unit: 2645

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Allan Hoosain
Primary Examiner
1/15/04